## REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed October 12, 2005. Having addressed all objections and grounds of rejection claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has prematurely issued the pending official action as final. He has done so, even though he has rejected all pending claims on newly cited prior art. In support of this premature finality, the Examiner clearly erroneously states:

> Applicant's amendment necessitated the new ground(s) of rejection presented in this office action.

This statement is clearly erroneous because claims 11-15 have never been amended. Yet, the Examiner has now finally rejected claims 11-15 under a newly cited ground of rejection in accordance with newly cited prior art. The Examiner has presented no explanation of how unamended claims 11-15 have necessitated the new grounds of rejection.

Similarly, claims 16-20 have previously been amended only to attend to certain editorial matters. Claims 16-20 clearly have not been amended in a manner to "necessitate the new ground of rejection presented in this office action" as stated by the Examiner. Therefore, the finality of the pending official action

should be withdrawn as based upon clearly erroneous findings of fact.

Claims 1-25 have been newly rejected under 35 U.S.C. 102(e) as being anticipated by newly cited U.S. Patent No. 6,810,429, issued to Walsh et al (hereinafter referred to as "Walsh"). This ground of rejection is respectfully traversed as to amended claims 1-25 for the following reasons.

The standard for a finding of anticipation during the examination process is specified in MPEP 2131, which provides:

**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "<u>The identical invention must be shown in as complete detail as is contained in the ... claim.</u>" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection of claims 1-25 as anticipated by Walsh is respectfully traversed because Walsh has not met the requirement that **"the identical invention must be shown in as complete detail as is contained in the ... claim"**.

Specifically, Applicants' invention as disclosed and claimed requires a legacy enterprise data base management system which produces a response to a service request wherein the requestor anticipates the service request to produce an XML result and wherein the response generated by the enterprise data base

10

management system **is in a legacy format, and not in XML**. As a result, the claimed invention requires structure to convert the "non-XML" response into an XML message.

Walsh, on the other hand, is concerned with converting non-XML inputs to XML for processing and storage and converting XML outputs to a non-XML format. Fig. 1b of Walsh, cited by the Examiner many times, clearly shows that web browser 124 communicates only in HTML/HTTP. Conversion to XML is required on input to enable the user to communicate with the system. Conversion from XML to HTML/HTTP is similarly required on output to communicate with browser 124.

Surely, the Examiner can distinguish between Applicants' production of a non-XML response to be converted into XML and Walsh's production of an XML output to be converted into a non-XML format. Walsh states in the Abstract the theme which is repeated throughout the disclosure stating:

> A front-end interface converts the output XML documents to output HTML forms.

This should be compare with Applicants' claim language (from claim 16, for example) requiring:

> ....converting said response into said XML document....

Because Walsh produces an XML output which is converted from XML and Applicants require production of a non-XML output which is converted to XML, Walsh cannot possible have the claimed structure as explained below in detail.

11

Specifically with regard to claim 1, the "response" and "conversion facility" make it absolutely explicit that the "response" is not compatible with the XML format and the "conversion facility" converts this response into an "XML message" for transfer back to the requesting user terminal.

Compare this with Walsh which converts "the output XML documents to output HTML forms". Therefore, Walsh does not have a "conversion facility" for converting non-XML responses into XML format, because the output documents are generated in XML. The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and further limits the "conversion facility" of claim 1. Walsh has no such "conversion facility". Therefore, it cannot have the limitations of claim 2 which further limit this structure. The rejection of claim 2, and any claim depending therefrom, is respectfully traversed.

Claim 3 depends from claim 2 and further limits the "conversion facility" of claim 1. Walsh does not have the "conversion facility" as explained above. Therefore, it cannot have the limitations of claim 3 which further limit this structure. The rejection of claim 3, and any claim depending therefrom, is respectfully traversed.

Claim 4 depends from claim 3 and further limits the "conversion facility" of claim 1. Walsh does not have the

"conversion facility". Therefore, it cannot have the limitations
of claim 4 which further limit this structure. The rejection of
claim 4, and any claim depending therefrom, is respectfully
traversed.

Claim 5 depends from claim 4 and further limits the
"conversion facility" of claim 1. Walsh does not have the
"conversion facility" as explained above. Therefore, it cannot
have the limitations of claim 5 which further limit this
structure. The rejection of claim 5, and any claim depending
therefrom, is respectfully traversed.

Claim 6 is an independent apparatus claim having three basic
elements. The second element of claim 6 is "a data base
management system having an internal format different from XML".
In support of his rejection, the Examiner cites Fig. 1b which
shows that virtually all transfers within the system are via XML
documents (see elements 102, 106, and 113) except the interface
with web browser 124 which is indicated as HTML/HTTP. Thus,
Walsh cannot meet this limitation.

The third element of claim 6 is the Output Definition Table
which converts the response into an XML document. As explained
above, the output of Walsh is in XML format. It does not need to
be converted to XML as claimed.

The rejection of claim 6, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to show anticipation as defined by MPEP 2131.

Claim 7 depends from claim 6 and is further limited by "Document Type Definition (DTD) which defines a format of said XML document". The XML document is the response, which has been converted from the legacy format. Again the Examiner cites the same material from Walsh which shows that Walsh explicitly cannot meet this limitation. The rejection of claim 7, and any claims depending therefrom, is respectfully traversed.

Claim 8 depends from claim 7 and is further limited by "a repository within said data base management system for storage of said Output Definition Table". Clearly, Walsh cannot meet this limitation. Therefore, the Examiner confusingly again cites the same portions of Walsh, which are irrelevant to the claimed element. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by "a window for user activation of said Output Definition Table". Walsh has no "window"; Walsh has no such user accessible "Output Definition Table"; and Walsh has no need for either of these. Therefore, the Examiner again cites the same portions of Walsh, which have nothing to do with the claimed limitations. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed network element. Because Walsh does not have the claimed network element, it cannot meet this further limitation. Nevertheless, the Examiner cites the same material from Walsh saying nothing of the claimed "Internet". The rejection of claim 10 is respectfully traversed.

Claim 11 is an independent method claim having four steps. The third step of claim 11 involves converting the response into an XML document. As explained above, Walsh generates its outputs as XML documents. Therefore, Walsh has no need to convert the output into an XML document as claimed. Therefore, the Examiner again cites the same portions of Walsh having no pertinence to the claimed invention.

The fourth step of claim 11 is limited by transferring the XML document produced by the third step via the publicly accessible digital data communication network. If the Examiner would but look at the oft cited Fig. 1b of Walsh, he would clearly see that Walsh only transfers using HTML/HTTP protocol.

Claim 11 has four steps. Walsh does not have these four steps. Therefore, the rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and further limits the conversion facility. As explained above, Walsh has no such conversion facility and has no need for same. Instead of

15

admitting this fact, the Examiner again cites the same figures of Walsh which do not show these added limitations. The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and further limits the Output Definition Table. Walsh has no Output Definition Table. Therefore, Walsh cannot have the further structure which limits the Output Definition Table. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the conversion process. Walsh has no such conversion process. Therefore, Walsh cannot have the further limitations. The Examiner again cites Walsh, Fig. 1b, 2 and 4 along with column 9, lines 51-67. As is clear from this citation, it does not meet the requirements of MPEP 2131. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the publicly accessible digital data communication network. Walsh does not have the limitations of the claims from which claim 15 depends. Therefore, Walsh cannot meet these further limitations. The rejection of claim 15 is respectfully traversed.

Claim 16 is an independent apparatus claim having four "means-plus-function" claim elements. As such, it is to be examined in accordance with MPEP 2181 et seq. Surprisingly, the Examiner has somehow find all of these elements within the oft

cited Figs. 1b, 2, and 4, along with the unrelated text at column 9, lines 51-67. As explained above in detail, not only does Walsh not have the claimed "converting means", it has no need for a "converting means", because Walsh generates its output as an XML document. Therefore, it has no need to convert the output to XML as provided by the claimed "converting means". Therefore, the rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and further limits the "processing means". Walsh has no "processing means", so it cannot have the further structural limitations to the "processing means". The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and is further limited by a "defining means" for creating the converted response. Walsh has no "service request", no "processing means" for processing the service request", no response generated by the processing of the service request, and therefore, has no "defining means" to define the response. The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the "transmitting means". Walsh does not have the "transmitting means" as claimed. Therefore, it does not have the further limitations of claim 19. The rejection of claim 19 is respectfully traversed.

Claim 20 depends from claim 19 and adds the further limitation of the "defining means" being stored in the "storing means". Walsh has none of these elements. Therefore, it cannot have the further limitations of claim 20. The rejection of claim 20 is respectfully traversed.

With regard to claim 21, the Examiner again ignores the requirement of MPEP 2131 requiring that "<u>the identical invention must be shown in as complete detail as is contained in the ... claim</u>". Instead, he again cites Figs. 1b, 2, and 4, along with column 9, lines 51-67, of Walsh which shows none of the claimed elements. In fact these citations specifically show that Walsh cannot anticipate claim 21. Even though Fig. 1b clearly shows that all communication with web browser 124 is in HTML/HTTP, the Examiner clearly erroneously alleges that this shows the claimed "transfer facility for transferring the XML message from the legacy data base management system to the user terminal". Similarly, the other four claimed elements of claim 21 are not shown "in as complete detail as is contained in the claim" as specifically required by MPEP 2131. The rejection of claim 21, and all claims depending therefrom, is respectfully traversed.

Claim 22 depends from claim 21 and adds further structure utilized in the conversion of the claimed first response from non-XML into XML format. As explained above, Walsh does not perform this conversion, because the output generated by Walsh

are already in the form of an XML document.  Therefore, Walsh cannot have the further limitations of claim 22.  The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and is further limited by a "repository" for storage of the "ordered sequence of command language script" utilized to honor the service request.  Walsh has none of this structure.  .The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and is further limited by "a window for user activation of the XML message at said user terminal".  As the Examiner is fully aware, Walsh discloses no window, as claimed; no user activation of the XML message; and no XML message at all at the user terminal.  It is deemed disingenuous for the Examiner to continue to cite the same material (i.e., Figs. 1b, 2, 4, along with column 9, lines 51-67) which does not relate to the claimed invention.  The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and further limits the claimed network.  Walsh does not meet the limitations of claim 24 from which claim 25 depends.  Therefore, Walsh certainly cannot meet the limitations of claim 25.  The rejection of claim 23 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this

19

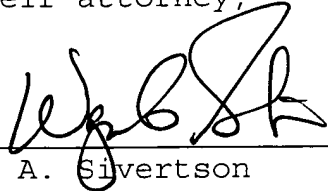amendment and allowance of claims 1-25, being the only pending

claims.

Please charge any deficiencies or credit any overpayment to

Deposit Account No. 14-0620.

Respectfully submitted,

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By their attorney,

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